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In the Supreme Court of the United States

Nos. 9, 10, 11. OCTOBER TERM, 1940.

THE SCHRIBER-SCHROTH COMPANY,
Petitioner,
vs.
THE CLEVELAND TRUST COMPANY, CHRYSLER CORPORATION,
Respondents.
No. 9.

THE ABERDEEN MOTOR SUPPLY COMPANY,
Petitioner,
vs.
THE CLEVELAND TRUST COMPANY, CHRYSLER CORPORATION,
Respondents.
No. 10.

THE F. E. ROWE SALES COMPANY,
Petitioner,
vs.
THE CLEVELAND TRUST COMPANY, CHRYSLER CORPORATION,
Respondents.
No. 11.

MOTION FOR LEAVE TO FILE SECOND PETITION FOR REHEARING and SECOND PETITION FOR REHEARING UPON THE MERITS AND UPON THE MOTIONS TO REMAND.

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THE GATES LEGAL PUBLISHING CO., CLEVELAND, OHIO

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MOTION FOR LEAVE TO FILE SECOND PETITION FOR REHEARING

Now come the respondents in these three cases and respectfully ask that they may have leave to file the attached second petition for rehearing,—both upon the merits and upon the motions to remand.

The reasons which they think justify the granting of this leave are:

1. In these same cases, in June, 1938, this Court provided a precedent by granting to the petitioners in these cases leave to file a second petition for rehearing, though this was many weeks after the first petition had been denied, and though the second petition set up no substantial grounds beyond those which had been set up in the first petition,—while the present proposed second petition is upon grounds not involved in the first petition.

2. The amendment which this Court on February 3 made to its opinion of December 9 placed the conclusion of the Court upon a new and different ground, to which new ground alone the attached second petition is devoted, and as to which new ground the attached petition is in fact the first petition for rehearing.

Dated, February 19, 1941.

ARTHUR C. DENISON,
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MILTON TIBBETTS,
Counsel for Respondents.

In the Supreme Court of the United States

Nos. 9, 10, 11. OCTOBER TERM, 1940.

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SECOND PETITION FOR REHEARING—UPON THE MERITS AND UPON THE MOTIONS TO REMAND.

To the Said Court:

Now come the respondents in these cases (pursuant to leave to file duly granted) and respectfully present this their second petition for rehearing, as above, praying that this cause be reheard or, in the alternative, that a remand be made for further hearing,—all for the reasons and upon the grounds now to be stated.

FOREWORD.

1. We assume that by its amendment of February 3 this Court did not intend to depart essentially from the basis of its original opinion or to announce any modification of the existing and familiar rules of the law of estoppel; but we hope hereby to demonstrate to the Court that it did make such essential departure, thereby leading to an erroneous application of the law of estoppel.

2. We assume that if the Court be convinced of the probability of this error, it will think proper either to reconsider its opinion of December 9, as amended February 3, or to make such an order of remand that the controlling facts, if they do not sufficiently appear by the present record, may be brought into the record by appropriate further testimony and exhibits.

PRELIMINARY CONSIDERATIONS.

1. The petition for certiorari (p. 8) presented three points only, (1) that because an essential element of the Jardine patented combination was not named in the claim but had been in fact surrendered, these proceedings in the Patent Office operated to make the Jardine patent invalid; (2) that it was error to suppose that web flexibility in operation must have been understood at the time of the supposed Long anticipation to be effectively existent therein; (3) that the nature of plaintiff's title did not permit an injunction.

Though the additional question of invention, as determined by the state of the art, was somewhat discussed orally, the Court, on December 9, apparently accepted the petition-imposed limitations in this situation, decided not to discuss points 2 and 3, and based its opinion entirely upon a question of file wrapper estoppel.

2. In its opinion of December 9 the Court apparently disapproved petitioners' contention that what happened as to *one element* could be controlling, and developed its

own theory[1] that the surrendered claim, as an entirety, was not different (save for "web flexibility") from the allowed claim, and therefore the latter could not be construed as contemplating "web flexibility." The Court declared that it was applying the established rule of file wrapper estoppel, by which a patentee may not recapture, by construction, a combination which he once surrendered. This lack of difference was accomplished by reading into the surrendered claim a number of elements which were named in the allowed claim but were not named in the surrendered claim, so as to eliminate the actual differences. It was not said that these other differences were immaterial; it was said that there were no differences.

3. This rule of estoppel is one of universal application; it has no peculiar basis or modification when it arises from the effect of Patent Office proceedings upon the claim of a patent. **Whatever rule of that law this Court has declared in this case must be considered and accepted by this Court in any future situation, parallel on principle, whether the question arises in any other kind of a contract case, or for that matter, in an equity or a tort case.**

4. In the opinion of December 9 it was assumed by the Court, and remains as the basis of the opinion, that, considering the Jardine specification and the claims in suit, the claims should rightly be interpreted as implying and calling for that kind and degree of "flexibility" which the specification described and showed to be essential to the intended and described operation of the device. It therefore must be accepted, as the basis of all thinking upon the subject matter later presented herein, that the patentee now would be, and at the time of the soliciting and issuing of the patent was, entitled to claim this construction of the language of his allowed claims,—*unless* prevented there-

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[1] The petitioners based point 1 (p. 8 of petition) upon *Permutit v. Graver*. That case did not involve, nor mention, file wrapper estoppel.

from by estoppel. It will be impossible to repeat this accepted basic theory of construction with every argument hereafter made; we think it is sufficient to state it thus once for all. The Court can not adopt this hypothesis as the basis of discussion, and then let its conclusion rest upon a rejection of this hypothesis.

5. In the opinion of December 9 this Court, in the manner and by the means stated in the foregoing paragraph 3, interpreted the cancelled claim 19-E as coextensive with the allowed claim 8, if the latter were thus construed to embody "web flexibility."

6. Upon the Petition for Rehearing and Motions we not only pointed out the several differences which demonstrated that the two claims were not coextensive, but also pointed out that these differences were material, *structurally, in mode of operation and in results obtained,* not only in fact, but in the opinion and intentions of the parties at the time; and we additionally established this materiality and these contemporaneous views by the affidavits of the two parties to the contract, showing that they were so considered by these parties at the time of the surrender of the cancelled claim.

7. In its amendment of February 3, in referring to these differences, the Court did not question their vital materiality *in structure, operation and results,* but attributed to them *a legal immateriality,* from the standpoint of invention;[2] and thereby substituted its view, ten years

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[2] The amendment says "in view of such want of invention [lacking web flexibility as found by the C. C. A.] and of the prior art, the only material difference between the amended [surrendered] and the allowed claims is [the one as to web flexibility]." We cannot interpret this otherwise than as meaning that from the standpoint of invention there was no other patentable difference between them,—in other words that, lacking web flexibility, the allowed claim was invalid for lack of invention over the prior art, as exemplified and supplemented by the surrendered claim.

later, and resorted to events and developments long subsequent to the surrender, to give to the surrendered claim a new interpretation which made these differences immaterial, and thereby to remove them from their position as otherwise insuperable obstacles to the rule of estoppel adopted by the Court.

ARGUMENT.

I.

An estoppel arising from an earlier statement or action of the party estopped (accepted by the other party so as to complete the essential agreement) must flow from the expressed or properly implied understanding and intention had, at the time, by the party estopped, as to the meaning of his statement or action. Years afterward, he cannot change his mind and assert that he did have or ought to have had some other intention or understanding, and thereby escape the estoppel which he had created; nor can any court years afterward change his mind for him and find that it had been his legal duty to know that his earlier act then had some meaning or effect different from what he then supposed it had, and so create against him an otherwise non-existing estoppel: This principle will not be questioned. An estoppel exists because the minds of the parties have met upon the meaning of the statement or act in question, and neither one of them can thereafter disavow that meaning, nor can any court do it for them, to make out an estoppel.

The application of the principle to Patent Office proceedings is simple and clear. The patentee, either by an express explanation and declaration in plain words, putting a construction upon his possibly ambiguous claim, or by the declaration implicit in modifying a claim so that it will not be met by a supposed anticipation, puts his construction upon the critical words; the Patent Office accepts this construction and issues the patent; the minds of the par-

ties have met and their agreement has become fixed; the intention and understanding of the patentee as to the meaning and scope of a claim he is cancelling is accepted and adopted by the Patent Office, expressly or by implication; and the meaning and the construction thus adopted by both parties is the only possible basis for a future estoppel as against some other alleged construction or meaning.

To make the application a step more concrete: The Patent Office allows claim A and rejects claim B; applicant acquiesces in the rejection of claim B and accepts claim A as the proper formulation of his allowable invention; there are differences,—several of them,—in structure and in operation between the claims; these were thought and agreed by Jardine and the Commissioner of Patents to be differences indisputably material and important in structure and in operation; one claim describing a practically successful, the other a practically useless, structure; the Patent Office concludes that these differences are material from the standpoint of invention and allows and issues to the applicant a patent with claim A while it issues to another a patent with claim B; the applicant has always contended, and agrees with the conclusion of the Patent Office, that the differences are material from the standpoint of invention and entitle him to a patent upon the invention of claim A; so the minds of the parties meet; the patentee may not thereafter say that claim A should be construed to give him also the structure of claim B; the Patent Office (or the public and whatever the fact about invention may be) may not thereafter say that the patentee had agreed that claim A was not patentably different from claim B; any such contention is in the teeth of the underlying facts.

An illustration:—A was in possession of two white cows, Bessie and Daisy; he made to B a bill of sale conveying "one white cow." Contemporaneous acts or papers

indicate that A intended to sell and B intended to buy Bessie; it later appears that A had a good title to Daisy but not to Bessie, and that his legal duty would have been to convey Daisy in exchange for B's money; but no court would say that, because this had been his legal duty, he would therefore have become estopped to deny that Bessie had actually been the subject of the conveyance. Estoppels operate to compel one to remain bound by an assertion which he did make, even though it were untrue; *an estoppel has never been thought to compel one to adopt an assertion which he did not make.*

II.

The Established Theory of File Wrapper Estoppel Does Not Permit the Use Made of It by the Court in Its Amended Opinion: The whole theory of the construction of claims by file wrapper estoppel is that because the patentee, in order to get his patent, has tied himself to a particular construction of the claim, and the Patent Office has thereupon issued the patent, he is estopped to deny that construction. The controlling thing in finding or not finding such a file wrapper estoppel is the state of mind and the beliefs of both parties to the contract at the time it was made. It cannot be important, on this issue, that some court, many years later, thinks that this joint contemporary view was a mistaken view. (*I. T. S. vs. Essex, post.*)

The Patent Office initially thought that the (earlier equivalent of) allowed claim was patentably different from the amended and later cancelled claim. It evidenced this view by putting the latter into interference and by allowing the former to remain as properly allowed. It confirmed this view by its various rulings on the interference. It later again confirmed this view by issuing a patent on the allowed claim to Jardine and issuing the patent with the cancelled claim to Hartog. In all of this Jardine acquiesced because, upon the Patent Office fact findings, it

was plainly right. The award of one claim to him and another claim to Hartog was made because the office thought, and Jardine thought, that the two claims were patentably different.

Now, because the Court thinks they were not patentably different (if that is what the Court's opinion means) we find that Jardine is estopped,—*not estopped to contradict the Patent Office ruling in which he acquiesced, but estopped to confirm it.*

This Court said in *I. T. S. v. Essex,* 272 U. S. 429, 443:

> "Whether the Examiner was right or wrong in rejecting the original claim, the Court is not to inquire."

The reason, of course, is that the estoppel is predicated upon what was surrendered, whether that surrender was right or wrong. The rule is manifestly applicable here for the same reason, and "the Court is not to inquire" here as to whether the Examiner was right in considering that the allowed claim was "from the standpoint of invention" materially different from the surrendered claim, and this prohibition is because the cancellation of the one and the allowance of the other were predicated upon the presence of what was, rightly or wrongly, thought to be a material difference; and whatever estoppel might exist in the instant case, would have to be based upon this thought, "right or wrong,"—just as in the cited case. The Court would not go back of the intention of the parties in the cited case. For the same reason it should not go beyond the intention of the parties in the case at bar. The patentee, in agreement with the Examiner, made his bed, and it is not to be made over either by the patentee or the Court,—and so this Court held in the cited case.

As an example—from the general law—of the logical limits of estoppel, see the case of *Deitrick v. Greaney,* 309 U. S. 190. There the Court, speaking through Mr. Justice Stone, said (p. 197):

"In a strict and technical sense an estoppel arises only when a misrepresentation has prejudiced another who has relied upon it."

From this viewpoint, would any Court expand the misrepresentation, or give the misrepresentation a wider or different scope than was given it by those parties by whom and to whom the misrepresentation was made?

Time and again this Court has said—

"We do not presume acquiescence in the loss of fundamental rights."

(See *Ohio Bell v. Public Utilities*, 301 U. S. 292, 307.) To the same effect is the statement by the Court at page 304 U. S. 464 (*Johnston v. Zerbest*) with citation to cases. See also *Aetna v. Kennedy*, 301 U. S. 393.

Having shown that the differences between the cancelled claim and the amended claim (other than the word "flexible") were material differences, how, in the face of these rules, is it proper to presume or construe them to be immaterial? Clearly the decisions of this Court which we have recited take the reverse view, that is, they have refused and frowned upon presumptions and interpretations which strike down a fundamental right such as that of Jardine to a patent upon his invention.

In the ordinary file wrapper estoppel the patentee is forbidden to contend that the difference between the cancelled and the allowed claims was immaterial, and so to recapture what was surrendered. The Court now does what the patentee could not do, and then declares the patentee to have become estopped by what he did not do.

If the view taken by this Court in its amended opinion regarding the immateriality of the differences (if flexibility be implied in the allowed claim) between the cancelled and allowed claims had obtained during the Patent Office proceedings and the cancellation (whereby the cancelled claims would have called for the structure and limitations

of the allowed claims), the following would inevitably have happened:

(a) These cancelled claims would never have been cancelled, because the other parties to the interference could not have made them, and the reasons for rejecting them would not have prevailed.

(b) Either the Patent Office would never have declared the interference or, if it had been declared, it would have been dissolved because the other parties to the interference could not have made the claims, and the cancelled claims would have been allowed to Jardine. It was only because of the material difference between the cancelled claims and the allowed claims that the cancelled claims were not allowed to Jardine and the allowed claims were allowed to him. These were the terms under which the surrender was made. To modify those terms more than ten years after they were cancelled changes the conditions under which they were surrendered.

(c) If somehow (though we can not conceive how) there had been an interference and the cancelled claim (construed as this Court now construes it), had been lost by Jardine, the Patent Office would never have given the allowed claims to Jardine, but he would have had an opportunity to select for his claims words and language beyond the ability of any to construe them as coextensive with, or no more than immaterially different from, the cancelled claims.

(d) The allowed claims would have been suggested by the Patent Office to the other parties to the interference, who would have made them and such allowed claims would then have been included in the interference.

(e) Jardine would have prevailed in the interference against all of the parties because he is the prior inventor of the subject-matter of the allowed claims.

(f) Jardine would have pursued his remedy by appeal from a holding predicated upon any such proposition as

the Court now adopts. To now construe as immaterial differences, then believed to be, held to be, and acted upon as material, would retroactively oust Jardine from his right to appeal. Every file wrapper estoppel is predicated upon the failure to pursue the remedy by appeal (*I. T. S. v. Essex*, 272 U. S. 429, 443).

We cite these instances not only to show the materiality of the differences between the claims, as the Patent Office and all the parties to the interference viewed them, but to emphasize the injustice of an *ex post facto* modification of what Jardine surrendered.

Indeed, it becomes manifest that very few, if any, patents would be worth the paper on which they are written if claims once made had been cancelled and if the Courts could, in the light of events occurring after the surrender, construe the surrender to be different from what was intended to be surrendered, and to be coextensive in substance with what was granted. Such a proceedings not only strikes down the inventor and his patent, but disparages the Government tribunal which was a party to the allowance of the grant which it made on condition of the surrender of a certain thing as then definitely understood,—which ought not to be later changed by construction to be something different.

The injustice and the evil do not end with the inventor and the Patent Office. They extend to counsel for the inventor, who are expected by the Court, and whose duty as officers of the Court it is, to limit the issues for consideration by the Court. In this case substantially all of the claims of the Jardine patent are infringed. Originally reliance was had upon claims 1, 2, and 4 to 11, inclusive (R. p. 34), a total of ten claims. The Master commented upon the burden placed upon the Courts by a reliance upon so many claims. Although all are infringed, we felt it was our duty to the Courts to limit the number of claims to be considered by reviewing Courts to relieve the burden upon such courts. The practice stated in *Great Northern v.*

General Railway, 55 Fed. (2) 457 (C. C. A. 8) presented us with the opportunity to do this without sacrificing any of the rights of our clients. It never occurring to us that the subject-matter surrendered by Jardine in the Patent Office would be construed in the light of later events—later even than our selection—to be something that it was not at the time it was surrendered, we limited the claims that might, under the circumstances, be considered by the reviewing Court in the light of the doctrine of the cited case, to claims 1, 8, and 11, though these were by no means the narrowest claims which were infringed. Other claims, such as claims 2 and 6, for example, contain further limitations and could not be construed as coextensive with or no more than immaterially different from the surrendered claims, even in the light of the opinion of the Court of Appeals and the prior art referred to by this Court in its amended opinion. If, therefore, this Court adheres to its amended opinion that the differences between the cancelled claims and claims 1, 8 and 11 of the Jardine patent are immaterial in the light of these subsequent events, we submit that justice requires the Court to remand the cause to the Court of Appeals that we, as counsel who selected the claims 1, 8, and 11 to lighten the work of the Courts, may have an opportunity to make a reselection in the light of the rule which this Court will have made, to the effect that the scope of the surrendered matter may be modified by construction in the light of subsequent events. The reasonableness of this request is sustained by the holding of all the Courts, who inferentially ruled, that the difference was material and by the absence of any holding that it was immaterial. The request is further made reasonable by the fact that the question of whether the differences between the claims is material or immaterial is necessarily a question of fact which has never been placed in issue and upon which evidence has never been taken and which has never been briefed or argued in any court.

That we did not by this selection of claims abandon the charges under the other claims of the Jardine patent originally relied upon and that we preserved our right to return to the others, is set forth in one of our briefs before the Court of Appeals when the selection was first made, as follows:

> "Many claims were allowed in the patents in suit after long prosecutions and many interferences. (*G. E. v. Save*, 82 Fed. (2) 100-103 (C. C. A. 6).) It seems impossible to get just the right number of claims in a patent, or in a patent suit, to suit everybody. Flagrant duplication of plaintiffs' licensees' whole line of pistons covered by the patents in suit, and the frequent injection of infringing pistons into the suit by defendants, made it necessary to rely originally upon a large number of claims. When the number and character of the infringing devices involved finally became static, we grouped the claims in accordance with the practice announced in *Great Northern v. General Railway*, 57 Fed. (2) 457 (C. C. A. 8)."

III.

The Question of Invention is Foreign to the Question of Estoppel: The differences (plus flexibility) between cancelled and allowed claims were either material or immaterial. The Patent Office and Jardine and the other interferants thought them material. This Court, in its amended opinion, thought them immaterial. Since their actual physical differences, in structure and operation and results, were beyond doubt important, the Court finds and applies another factor—"lack of invention in the allowed claim, absent flexibility." The "prior art" also referred to in the amended opinion could have been no more than the prior art in this record on which the Court below had based its finding and hence adds nothing to that finding.

So we find the Court inferring that *because* the allowed claim was patentable only if it implied flexibility, *therefore* all its several express differences from the cancelled claim

were immaterial to a decision of the question of estoppel. We submit, with all deference, that this is *non sequitur* upon which the Court will not be content to let its amended opinion rest.

The opposite conclusion seems more forceful. If indeed there were inconsistency between the cancellation of the amended claim and the allowance and issue of claim 8 (construed with flexibility as the specification requires) then the allowance and issue, being later, would prevail. This is the doctrine of *Smith v. Snow*, 294 U. S. 1, 16 (opinion by Mr. Justice Stone). A narrower claim had been rejected, with acquiescence by applicant, who later secured a broader claim, which this Court sustained, as having superseded the earlier action.

IV.

Deformation Bending and Flexible or Yielding Bending: We have, in each of our briefs in this Court, urged, and at page 7 of our green brief (Respondents' Reply Brief on the Motions to Remand and Petition for Rehearing) illustrated the action of "deformation" bending described in the Jardine patent (p. 1, ll. 21-28). This deformation bending results in an operation and the achievement of merits including the balanced skirt flexibility of which the parties to the interference, Long, Hartog and Spillman, were incapable since the bending in the parts of their pistons is merely the common flexing or yielding bending recited in the cancelled claims. *No cancelled claim recited this "deformation" bending.* No language of any cancelled claim could be construed to mean the "deformation" bending because to have so construed it would have been to make it impossible to read upon structures of the other parties to the interference. Since Jardine must construe his claims in the light of his specifications, his webs must be construed as bending by "deformation and deflection." Thus the difference between the surrendered and allowed

claims includes a difference in the character of the bending and even though Jardine may have surrendered a claim reciting the yielding or flexing bending generally or broadly, he never surrendered a claim reciting, or which could be construed as reciting, a "deformation" bending.

Or perhaps the proposition could be better understood if looked at from the following standpoint:

The Jardine webs are capable of both (1) the broad flexing or yielding bending and (2) the "deformation" bending. The parts of the pistons of Long, Spillman and Hartog were incapable of the latter or deformation bending. If it be assumed that Jardine surrendered the broad yielding or flexing bending, or any combinations including that feature, he never surrendered the "deformation" bending or any combination claim either including that feature or into which that feature might be construed. Since, under the law of this case and under the general rule, Jardine's claims must be construed in the light of his specification, they must be construed as including the "deformation" bending as well as the yielding or flexing bending, and as so construed they would not be coextensive with any surrendered claim for the reason, *inter alia*, that they would be limited to the "deformation" bending.

The record shows that this feature is present in Jardine and in the accused pistons, Exhibit 1, along with the other features (R. pp. 37-41).

V.

Materiality or Immateriality of Differences Between Claims is a Question of Fact: Time and again this Court has said that claims cannot be construed on the basis of the words of the claims. Time and again this Court has said that claims must be construed in the light of what is done by the structures the claims describe and how they do it. The cancelled claims describe the structures of Spillman, Hartog and Long, all of which operated and per-

formed so differently from Jardine that they failed where Jardine succeeded. The allowed claims describe Jardine, but do not describe any one of the pistons of Long, Spillman or Hartog. The Patent Office considered that the difference between the allowed and the cancelled claims was so great that the allowed claims were patentable to Jardine and the other claims were not. Thus there is presented a fact issue here with a judicial holding to sustain the *prima facie* materiality of the differences between the claims. (*Mumm v. Decker*, 301 U. S. 168; *Radio v. Radio*, 294 U. S. 1.) Moreover, the Patent Office is the only tribunal which has ever been presented with this issue, the evidence on the same, and which has ever been confronted with the reasons for deciding it one way or the other.

Therefore, before this fact issue can be considered by this Court, at least to the extent of reversing the *prima facie* conclusion of the Patent Office, the question should be presented as an issue to the trial Court, evidence submitted upon it, arguments and briefs had and a decision by the trial Court on the question which should be brought up to this Court for review.

As the matter now stands this Court has decided this question, which is essentially and fundamentally a question of fact, contrary to and overruling the Patent Office and without evidence upon the question or without a decision below which this Court could properly review.

VI.

The Prior Art mentioned in the amendment to this Court's opinion is not named and, therefore, we cannot deal with it directly.

It must, of course, be either the prior art that was before the Patent Office at the time of the surrender of the cancelled claim and the making of the allowed claim or prior art which was not before the Patent Office and the solicitor at that time.

If it was the former, the Court will not, on the file wrapper proceedings, consider whether the action of the Patent Office with respect to the prior art was right or wrong. (*I. T. S. v. Essex, supra.*)

If it was prior art not before the Patent Office and the solicitor it manifestly cannot be considered in construing what was surrendered, any more than any other fact which was not before the parties at the time of the surrender, because to do so would give to the cancelled claim a construction not intended to be given to it at the time of the surrender, and resulting in attributing to Jardine the surrender of something which he did not surrender.

Conclusion: The Jardine invention stands before this Court as an invention of great merit. The holding of the Court of Appeals was that it was an invention of great merit advancing the art so substantially that it was the first solution of the aluminum piston problem which had, for years, baffled those most skilled in this art in this country and abroad, and which had not been solved by all of their efforts. That finding was not challenged by the Petition for Certiorari and is not here for review. We assume that the Court will accept the views of the Court of Appeals upon that subject, as it has accepted the view of the Court of Appeals that there was no invention in the Jardine claims "absent the flexible web element." The evidence of the defendant, as well as that of the plaintiff, supports the finding of the Court of Appeals on the presence of invention and its great merit.

Under such circumstances the Courts will, as this Court has time and again said, be "liberal in its construction of the patent to secure to the inventor the reward he deserves" (*Eibel v. Paper Co.*, 261 U. S. 45, 63; *Morley v. Lancaster*, 129 U. S. 263, 273; *Hildreth v. Mastoras*, 257 U. S. 27, 36). This is no more than the broad equity rule that where one has contributed substantially to the bene-

fits of his fellow men, his fellow men will not be dialectic or squeamish with him.

Would it not seem that it is time to take stock to see whether or not Jardine, the inventor of a meritorious invention, is being treated with that liberality which this Court has always proclaimed it would mete out to those who make meritorious inventions.

A review of the progress of this invention through this Court leads to the conclusion that it is time to contemplate the rule which we have cited. The progress through this Court is as follows:

(1) There was a controversy through the lower Courts on the question of whether the original Gulick application used the word "rigid," in describing a property of the webs, as referring to the vertical or the horizontal. Three Courts of Appeals, including in all thirteen Judges, decided that the reference in the specification was to the vertical. This Court disagreed with them, and held that the amendment to that effect was improper.

(2) It was also urged through all of these Courts that since flexibility was inherent in the webs of Gulick they should be so construed and both the defendants' and the plaintiffs' experts testified that no one making a piston such as disclosed in the Gulick patent could make the piston otherwise than with a flexible web, if any metal available for piston use was employed. The three Courts of Appeals below agreed with this. This Court disagreed.

(3) The same thing was urged with respect to the Maynard patent for the same reason, and this Court still held the disclosure insufficient to teach those skilled in the art.

(4) We then pointed out that Gulick and Maynard claims were valid nevertheless since they recited the webs. This Court then remanded the case to the Court of Appeals to decide this question and also, *inter alia*, the question of the validity of the Jardine patent.

(5) Since it was impossible to say the Gulick and Maynard webs were neutral, the Court of Appeals either had to construe them as flexible or as rigid, and having been forbidden by this Court, as that Court thought, to construe them as flexible the Court of Appeals construed them as rigid, though that was just as much a violation of the rule made by this Court as the construction that they were flexible.

(6) On the Jardine patent the Court of Appeals held, according to a well established principle of law and of contracts, that since one part of a contract could be construed in the light of another part, the claim could be construed in the light of the Jardine specification.

(7) Both parties applied to this Court for Certiorari. Although the question of construing rigidity into the Gulick claims was a novel one, and the question of construing the Jardine claim in the light of the specification was an old and familiar one, this Court denied the Petition for Certiorari on the former and granted the Petition for Certiorari on the latter.

(8) In its Petition for Certiorari on the Jardine patent, petitioners under Point I raised two questions of patent law, as follows:

(a) If a party cancels a claim which includes, as one of several features, a particular one i.e., flexible, can that party later construe a different and allowed claim, in the light of his specification, so as to include that particular feature?

(b) Could Jardine construe his claim in the light of the specification to say that the web was flexible?

(9) This Court rejected both of these propositions, deciding the case on the ground that the cancelled and the rejected claims should be construed as co-extensive except for the term "flexible," notwithstanding differences in the claims. We responded by showing that to do this would

do violence to what had been agreed upon at the time between the Patent Office Examiner and the solicitor and give the cancelled claim a construction that it could not possibly have had in the light of the fact that it was construed to read upon the applications of Long, Spillman and Hartog.

(10) This Court then amended its opinion to hold that in the light of subsequent events and certain prior art, which was not named, the differences between the claims must be construed as immaterial, thus, as we point out herein, changing by construction the thing that was surrendered to create out of whole cloth a claim which was never surrendered.

We live in an age of great reforms most, if not all, of which are predicated upon the more equitable distribution of wealth, comforts, benefits, etc. Few, if any, of the things which these reforms seek to distribute were available a century ago. The man who worked on the Boulder Dam was four thousand times as strong as the man who worked on the Great Pyramid; the same relation existed three hundred years ago; it was little changed one hundred and fifty years ago. Why these differences? Why do we have these emoluments to distribute today? The answer is that tools, etc. have been invented which made the man on the Boulder Dam four thousand times stronger than the man on the Great Pyramid. Substantially all of these tools, etc. have been invented since the early part of the last century when the Courts for the first time began to apply the rule stated by this Court in *Eibel v. Paper Company* and other decisions, cited *supra*.

Should those who invent and produce the tools, etc. which produce the emoluments available for distribution in these reforms be treated captiously? Certainly not under the prior decisions of this Court which we have cited!

In view of all of these things it would seem that the Court should—

(1) Remand the cause to the District Court with directions to take evidence upon, consider and decide the questions which this Court has raised for the first time, and which we have enumerated in the proceedings since the coming down of the first opinion of this Court;

(2) Grant a rehearing that the Court may consider the case free from the propositions which have been taken into consideration in rendering the opinion and the amended opinion and which matters were neither placed in issue, submitted to trial, or decided below;—or

(3) Dismiss the writ, because the former controversy is now moot. Whether the defendants should pay some damages is not a question of public interest. No question of public interest remains,—unless it is the question whether the Court has inadvertently and unduly modified the general law of estoppel.

Respectfully submitted,

ARTHUR C. DENISON,
F. O. RICHEY,
WM. C. MCCOY,
MILTON TIBBETTS,
Counsel and Solicitors for Respondents.

February 19, 1941.

We hereby certify that the foregoing petition for rehearing is presented in good faith and not for delay.

ARTHUR C. DENISON,
F. O. RICHEY,
WM. C. MCCOY,
MILTON TIBBETTS,
Counsel and Solicitors for Respondents.

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SUPREME COURT OF THE UNITED STATES.

Nos. 9, 10, 11.—OCTOBER TERM, 1940.

The Schriber-Schroth Company, Petitioner, vs. The Cleveland Trust Company, Chrysler Corporation.	On Writs of Certiorari to the United States Circuit Court of Appeals for the Sixth Circuit.
The Aberdeen Motor Supply Company, Petitioner, vs. The Cleveland Trust Company, Chrysler Corporation.	
The F. E. Rowe Sales Company, Petitioner, vs. The Cleveland Trust Company, Chrysler Corporation.	

[December 9, 1940.]

Mr. Justice STONE delivered the opinion of the Court.

Decision in these cases turns on the question whether, in the light of the patent office history of the Jardine patent on a piston for gas engines, the court below, in construing the specifications and claims, erroneously included one element, "flexible" or "yielding" webs in the patented combination.

A related question was considered by this Court in connection with the Gulick and Maynard patents, also involved in this litigation, in *Schriber-Schroth Company* v. *Cleveland Trust Co.*, 305 U. S. 47. Respondent, the assignee in trust under a pooling agreement of some eighty patents relating to pistons for gas engines. It brought suit in the district court for northern Ohio against petitioners, three piston dealers, customers of the Sterling Products Company, to restrain infringement of five of the patents, including the Gulick patent No. 1,815,783, applied for November 30, 1917 and allowed July 31, 1931, the Jardine patent, No. 1,763,523, applied for March 11, 1920 and allowed June 10, 1930, and

the Cleveland Trust Co.

the Maynard patent No. 1,655.968, applied for January 3, 1921 and allowed June 10, 1928.

The cases were consolidated and tried before a special master who, upon the basis of elaborate special findings, concluded that the Gulick patent was invalid because of want of invention and because of the addition to the application by amendment in 1922 of a new element of the alleged invention; that the Maynard patent was invalid for want of invention and for failure to describe and claim the alleged invention, and that the Jardine patent was invalid as not showing invention over the prior art exhibited by Ricardo, Franquist and Long. He held the other patents invalid for reasons not now material.

The district court adopted the master's findings and gave its decree for petitioners. The court of appeals reversed as to two of the five patents, holding the Gulick and Maynard patents valid and infringed. 92 F. (2d) 330. The elements of the combination as stated in claim 39, ~~one of several claims~~ of the Gulick patent ~~which the court sustained~~, are:

> "A piston for an engine cylinder comprising a skirt, a head separated from the skirt wall around its entire periphery, said skirt being longitudinally split to render the skirt wall yieldable on every diameter in response to cylinder wall pressure, wrist pin bosses, and means rigidly connecting said bosses to the head and yieldingly connecting said bosses to the skirt whereby said skirt is yieldable in response to cylinder wall pressure."

References to a combination, including with other elements web connections "whereby said piston skirt is rendered yieldable during operation in response to cylinder wall pressure" appears in number 18, ~~another~~ one of the sustained claims.

The court of appeals found invention in both the Gulick and Maynard patents, in a combination of elements of which one was "webs laterally flexible", which was not specifically described or claimed in the Gulick patent before its amendment of 1922 and was never so described or claimed in the Maynard patent.

Conceding that other elements in the combinations were old in the piston art it said: "But to combine insulation of head from skirt, retraction of the bosses from the skirt periphery, connection of such bosses to the skirt with webs laterally flexible and yet so carried from the head as to support the load upon the wrist pin

with sufficient strength and rigidity, and to utilize the mechanical force of the cylinder wall upon the skirt and the thermal expansion of the bosses so as to compensate evenly and fully for head expansion and to secure a balanced flexibility of the skirt with no bending concentration at any point therein, discloses, we think a meritorious concept beyond the reach of those skilled in the art". 92 F. (2d) at 334.

Upon an examination of the Gulick application before amendment and the Maynard patent we concluded, 305 U. S. 47, that neither described or claimed flexible or yieldable webs as an element in the patented inventions. For that reason alone we held that if the flexible web constituted an essential element of the inventions both patents failed to satisfy the requirement of the statute that the patentee describe his invention so that others may construct and use it after the expiration of the patent and that it "inform the public during the life of the patent of the limits of the monopoly asserted, so that it may be known which features may be safely used or manufactured without a license and which may not." *Permutit Co.* v. *Graver Corp.*, 284 U. S. 52, 60; that consequently the patent monopoly did not extend beyond the invention described and explained by the patent as the statute requires and could not be enlarged by amendment so as to embrace in the invention an element not described or claimed in the application as filed, at least when adverse rights of the public had intervened. See *Schriber-Schroth Co.* v. *Cleveland Trust Co., supra*, 57.

Upon the remand the court of appeals held in the present suit, *Schriber-Schroth Co.* v. *Cleveland Trust Co.*, 108 F. (2d) 109, that the elements of the combination described and claimed in the Gulick patent before amendment and in the Maynard patent without including the flexible web element which was added only by amendment to the Gulick patent, did not disclose invention over the prior art. But considering that the flexible web element which had not been included in the combination patented by Gulick and Maynard had been described and claimed in the Jardine patent, it recalled its mandate to the district court by which it had directed dismissal of the suit brought on that patent. See *Schriber-Schroth Co.* v. *Cleveland Trust Co., supra*, 112, 113. Upon an examination of the Jardine specifications and claims it found there described and claimed the invention which it had previously

without prejudice

found in Gulick and Maynard, but which this Court had found the patentees had failed to describe and claim in their applications.

The Jardine claims, 1, 8 and 11, which it sustained, recite the webs as an element but do not describe them as flexible or point to flexibility as an element in the invention claimed. But in the specifications of the patent, which so far as now material appeared in Jardine's application describing the invention, he makes specific reference to the webs constructed in such proportions as to enable them to "bend" in response to the reaction force of the cylinder wall on the outer faces of the guide segments as the piston expands, and to the cooperation of the "bending" web with the thermal expansion of the guide part of the piston without a corresponding increase in its outer diameter.[1] He explained the principle of his device saying, "I have found that these difficulties can be overcome by constructing a piston with its skirt or guide portion supported and slotted or divided in a manner to permit deformation and deflection of parts thereof without interfering with the performance of the essential functions of the respective parts."

Reading specifications and claims together, the Court of Appeals interpreted the latter as incorporating the element of web flexibility in the combination claimed and concluded that Jardine had explained and claimed "the principle of operation of his machine and the flexibility of its webs". It said that "the knowledge that was not Gulick's or was by him concealed is clear to Jardine and by him proclaimed." It held the Jardine patent valid and infringed as it had found Gulick infringed in its earlier decision.

We granted certiorari, 309 U. S. 648, on a petition which raised, among others, the question whether the court of appeals had misin-

[1] An excerpt from the Jardine Specifications reads:

"The webs 6 and guide segments preferably are so designed that this displacement of the segments 10, 10^a, is permitted by virtue of a bending of the webs 6 at points remote from the guide segments. To this end, as shown in Fig. 4, the thickness of the guide segments is increased toward the webs 6 and the webs 6 are decreased in thickness from the guide portions inward toward the bosses to points in line with the inner ends of the slots 11^a. This gives in effect a cantilever structure weakest at its support, . . . Thus the reaction force of the cylinder wall on the outer faces of the guide segments as the piston expands tends to cause bending of the webs 6 along said lines 13. Due to the bending of the web sections 6 and the forcing together of each pair of segments, the guide part of the piston may undergo a considerable thermal expansion without a corresponding increase in the outer diameter thereof and thus a small initial clearance can be used without danger of scoring or seizure of the piston."

terpreted or unduly limited this Court's earlier decision in this case and its decision in *Permutit Co.* v. *Graver Corp., supra,* by refusing to hold a patent invalid where a feature found to be an essential element of the patented combination was not mentioned in the claims of the patent and was in fact surrendered during the prosecution of the application and after adverse decisions in interferences.[2]

The claims of a patent are always to be read or interpreted in the light of its specifications, *Hogg* v. *Emerson,* 11 How. 587; *Carnegie Steel Co.* v. *Cambria Iron Co.,* 185 U. S. 403; *Smith* v. *Snow,* 294 U. S. 1; and we may assume that if in the present case the specifications and claims of the patent were to be interpreted without reference to its file wrapper history, the webs referred to in the claims are the webs described in the specifications as capable of bending in cooperation with the slotted piston guides or skirts so as to compensate for thermal expansion and so supply the element of webs laterally flexible which was wanting to Gulick and to Maynard. But the particular invention to which the patentee has made claim in conformity to the statute is not always to be ascertained from an inspection of the specifications and claims of the patent alone. Where the patentee in the course of his application in the patent office has, by amendment, cancelled or surrendered claims, those which are allowed are to be read in the light of those abandoned and an abandoned claim cannot be revived and restored to the patent by reading it by construction into the claims which are allowed. Hence, petitioner argues, the effect to be given to the omission from the Jardine claims of any reference to the flexible web feature, which the court below thought distinguished his alleged invention from that of the Gulick and Maynard patents, cannot rightly be determined without some examination of the claims pointing to flexible webs as a feature of his invention, which Jardine added to his application by amendment and later surrendered as a result of interference proceedings in the patent office.

[2] A question raised by the petition for certiorari was whether respondent could prosecute its suit for injunction in the absence, as a party, of the licensee to whom respondent had granted the exclusive right to manufacture, under the patents in question, aluminum pistons, the only field in which concededly the patent has present practical utility. The special master found against petitioners on this point and no exceptions were taken to his finding, nor was the point argued when the case was first before the circuit court of appeals and this court. The court below thought that in view of these circumstances the right of respondents to an injunction was no longer an issue. We do not here pass on the question since we find that, in any case, for reasons appearing in the opinion, no injunction should issue.

The Jardine patent was described as of the slipper type of piston although not limited to that type, the skirt consisting of two separated parts circumferentially separated from the piston head, supported by the webs which connect the skirt or slippers with the piston head and support wrist pin bosses from which the skirt is retracted or cut away. The claims of the Jardine application as filed or later amended and ultimately allowed made no reference to the webs as flexible, yielding, or resilient, which the court of appeals found, when cooperating with other structural elements, to be a distinguishing feature of Jardine's invention. Claim 8 of the Jardine patent, which is typical of the three which the court below sustained, reads:

> "In a piston for an internal combustion engine, the combination of a head having a cylindical ring flange, oppositely disclosed webs integral with the flange and carrying diametrically opposite piston pin bosses, and skirt integral with said webs and cut away to expose the sides of said webs and separated from the ring flange by circumferential slits and provided with a longitudinal slit disposed between the ends of the webs."

Claims 5 and 6 refer to the "skirt portion cut away from the head to expose the bosses."

While the application was pending Jardine amended his claims so as to supply this omission. In various forms he claimed the ~~cylinder~~ piston head, skirt and web combination with ~~cylinder~~ piston head separated at its flange or periphery from the skirt, the skirt slotted or separated into parts and connected with the head by the webs, variously described as "yielding ribs", "resilient arms", "skirt carriers . . . susceptible of being slightly flexed radially" or as "joining means being resiliently yieldable", or as "means for yieldingly connecting the said skirt section with said head". These claims, as a result of being thrown into interference with Hartog, No. 1,842,022, applied for February 16, 1920, allowed January 19, 1932, and in some instances with Gulick and with Long, No. 1,872,772, applied for March 7, 1919, allowed August 23, 1932, were rejected by the patent office. Jardine then withdrew all of these amendments. Of these amended and cancelled claims, Claim 18 [19 E] is typical. It reads as follows:

> "In a piston of the class described, a cup-like head comprising a pressure receiving end and a wall portion, a skirt, circumferentially disconnected from the wall portion of the head and divided from end to end, and skirt carriers connecting said

skirt to the pressure receiving end, said skirt carriers being disconnected from the wall portion of the head and susceptible of being slightly flexed radially."

Upon comparison of the withdrawn claim with Claim 8 of the patent as allowed it will be observed that both are combination claims for a piston having a head, a divided or slotted skirt disconnected from the wall portion of the head and connected with the head by ribs, webs or skirt carriers. The only material difference in view of what has been said to be the invention is the statement in the withdrawn claims that the skirt carriers (webs) are "susceptible of being slightly flexed radially" or the like. Whatever would have been the proper construction of the claims as allowed, read in the light of the specifications alone, there being no amendments, the question now presented is whether in view of the amendments and their withdrawal the patent can rightly be construed as including the flexible webs in the claim allowed.

In addition to the fact of the cancellation of the only claims specifying flexing webs or their equivalents as a feature of the invention, it is to be noted that at no time during the prosecution of the Jardine application did he urge that he was the inventor of a piston having flexible webs. Before the interferences and in distinguishing his invention from the Ricardo piston, Jardine urged as his only advance over Ricardo the addition of the slotted skirt which "changes the structure and the resistance to a disposal of the forces within and without the piston when the piston is in use", although in this litigation it is contended that the Ricardo patent did not disclose flexing webs. In submitting the final amendment cancelling the flexible web claims in interference and presenting the claims 8 and 11 of the Jardine patent held valid by the court below, there is no mention of flexing webs, the features stressed being in the case of Claim 8 that the webs are integral with the ring flange and in the case of Claim 11 that the webs are integral with the flange and extend "convergingly inwardly" therefrom.

It is a rule of patent construction consistently observed that a claim in a patent as allowed must be read and interpreted with reference to claims that have been cancelled or rejected and the claims allowed cannot by construction be read to cover what was thus eliminated from the patent. *Shepard* v. *Carrigan*, 116 U. S. 593; *Sutter* v. *Robinson*, 119 U. S. 530; *Roemer* v. *Peddie*, 132 U. S. 313; *Phoenix Caster*

Co. v. *Spiegel*, 133 U. S. 360; *Hubbell* v. *United States*, 179 U. S. 77; *Weber Electric Co.* v. *E. H. Freeman Electric Co.*, 256 U. S. 668; *I. T. S. Rubber Co.* v. *Essex Rubber Co.*, 272 U. S. 429, 443. The patentee may not, by resort to the doctrine of equivalents, give to an allowed claim a scope which it might have had without the amendments, the cancellation of which amounts to a disclaimer. *Smith* v. *Magic City Club*, 282 U. S. 784, 790; *Weber Electric Co.* v. *E. H. Freeman Electric Co.*, *supra*, 677, 678; *I. T. S. Rubber Co.* v. *Essex Rubber Co.*, *supra*, 444. The injurious consequences to the public and to inventors and patent applicants if patentees were thus permitted to revive cancelled or rejected claims and restore them to their patents are manifest. See *Leggett* v. *Avery*, 101 U. S. 256, 259.

True, the rule is most frequently invoked when the original and cancelled claim is broader than that allowed, but the rule and the reason for it are the same if the cancelled or rejected claim be narrower. *Morgan Envelope Co.* v. *Albany Paper Co.*, 152 U. S. 425, 429; *Wm. B. Scaife & Sons* v. *Falls City Woolen Mills Co.*, 209 Fed. 210, 213; see *Computing Scale Co.* v. *Automatic Scale Co.*, 204 U. S. 609, 620, 621; cf. in case of disclaimer *Altoona Theatre Co.* v. *Tri-Ergon Corp.*, 294 U. S. 477, 492, 493.

In view of the prior art which precluded, as the court below held, invention in Gulick and Maynard, absent the flexible webs, and in Jardine without the inclusion of the surrendered flexible web feature in the patented combination, it does not appear why the patent office allowed the broad claims after rejecting the narrower ones. But in any case the patentee, having acquiesced in their rejection, is no longer free to gain the supposed advantage of the rejected claims by a construction of the allowed claims as equivalent to them. *Morgan Envelope Co.* v. *Albany Paper Co.*, *supra*.

The application of that principle in the present case is not foreclosed as respondent suggests because the combination of elements surrendered differs from the combination which the court below found to be preserved in the allowed claims and in which it found invention. The combination which it found to be preserved in Jardine's claims was "a combination with balanced skirt flexibility due to cooperation of longitudinal and vertical slotting with flexing webs supporting retracted bosses and connected to a skirt thereby made responsive to physical compression and thermal expansion so

as to permit of minute clearances between piston and cylinder, a concept perceived in Gulick as amended and minus amendment no longer perceived." 108 F. (2d) 114.

But the amended and cancelled claims are to be read in the light of the specifications. So read cancelled claim 18 [19 E] already quoted claims a piston "of the class described" and embraces the combination in which the court below found invention, longitudinal and vertical slotting, flexing webs supporting "retracted bosses" and connected to a skirt thereby made responsive to physical compression and thermal expansion. True the amended and cancelled claim and allowed claims 1, 8 and 11 did not specifically mention retraction of the skirt from the bosses. Nor did either the amended claims or the allowed claims specify balanced skirt flexibility due to cooperation of the parts. For them recourse must be had to the specifications and drawings in which the court below found the elements of the invention which it described found the elements of the invention which it described but in which, absent the flexible webb element, it found no invention. In view of such want of invention and of the prior art the only material difference between the amended and the allowed claims is the presence in the former of the flexible webb element and, in consequence of the surrender of the former particularizing sed invention if the flexible web feature had not been surrendered. Without it the court below concluded that Jardine, like Gulick and Maynard, disclosed no invention. It rejected the Schmiedeknecht patent, No. 1,256,265, one of those in suit, on like grounds, saying, "It discloses no web flexibility cooperating with other elements of resiliency to achieve the balanced flexibility perceived in Jardine on the basis of which alone the latter is thought to be valid . . ." We accept this conclusion as supported by the evidence of the prior art in the master's findings and the only one which could be reached consistently with the decision below with respect to the Gulick and Maynard patents which stand adjudged as invalid.

Reversed.

Mr. Justice McReynolds and Mr. Justice Roberts took no part in the consideration or decision of this case.